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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/076,131	02/13/2002	Babu J. Mavunkel	219002028310	9859
25225	7590	04/19/2004		
MORRISON & FOERSTER LLP 3811 VALLEY CENTRE DRIVE SUITE 500 SAN DIEGO, CA 92130-2332			EXAMINER CHANG, CELIA C	
			ART UNIT 1625	PAPER NUMBER

DATE MAILED: 04/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/076,131

Applicant(s)

MAVUNKEL ET AL.

Examiner

Celia Chang

Art Unit

1625

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 February 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 03/22/04. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

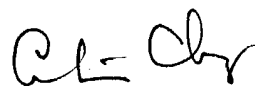

CELIA CHANG
PRIMARY EXAMINER
GROUP 1200/1625

Art Unit: 1625

~~—ATTACHMENT TO ADVISORY—~~

The amendment and remarks filed in Paper No. 8, dated Feb. 23, 2004 have been considered carefully but are deemed to be not persuasive and will not be entered for the following reason:

1. Because many arguments resulted from which set of specification was correct and applicants did not follow MPEP in filing a substituted specification such arguments at this late stage of prosecution raised new issues. Therefore, the amendments based on such arguments will not be entered for reconsideration.
2. The amendments did not correct all the 112 issues as well as obviate the art rejection. See for example, in proposed new claim 39, it reads R4 is an “aryl *including one or more heteroatoms selected from O, S, and N...*” Not only it is unclear as to what this including mean, substituted? Ring heteroatom? Etc. It was given the broadest interpretation thus will read on compounds of RN 562082-85-3 since both heteroinclusion in the ring and as substituents exist. Arguments presented by applicants are based upon “what” applicants are considered as inclusive or exclusive of the newly substituted specification. Because the specification was not even verified at the time the second office action was issued, such arguments must be considered as new issues. Therefore, the amendments based on such arguments will not be entered for reconsideration.


CEILA CHANG
PRIMARY EXAMINER
GROUP 1200 (C/S)